

Appl. No. 10/027,343  
Amendment dated June 12, 2003  
Reply to Office Action of March 24, 2003

### **REMARKS**

The amendment to claims 23 and 28 has corrected an oversight, in that the element of a frangible portion did not have antecedent basis in the previous independent claim.

#### **Claim rejection under 35 U.S.C. §112**

The Examiner has rejected claims 23 and 28 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. The element of a "frangible portion" in both claims 23 and 28 did not have antecedent basis in the preceding independent claim. However, the preceding dependent claims, 22 and 27, did recite such element. Thus, claim 23 is now dependent upon claim 22 and claim 28 is now dependent upon claim 27. The Applicants thank the Examiner for pointing out this technical oversight.

#### **Claim rejection under 35 U.S.C. §102**

The Examiner's rejection of claims 1, 4, 10, 11, 15, 16, 19 – 21, 24, 25, 29, 32, 36 and 37 under 35 U.S.C. §102(b) as being anticipated Freitas et al. (U. S. Patent No. 5,486,185) is traversed.

The Freitas et al. surgical apparatus is used in laproscopic surgery. The Freitas et al. device comprises a probe having an instrument attached to one end, which is inserted into the patient. Slidably disposed over the probe is a sliding sleeve, which applies force to the instrument on the probe to affect the desired action. The Applicants would acknowledge Freitas et al. is applicable prior art, however, a careful reading of the reference points out a substantial difference between the Freitas et al. device and the presently claimed surgical instrument. The

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Freitas et al. device utilizes a probe sleeve 28, which surrounds an immovable probe, which is attached to the instrument head 20. Operation of the Freitas et al. device is accomplished by moving the outer probe sleeve over the instrument head 20 so that camming surfaces 40 and 42 are engaged by the inside of the probe sleeve 28 on the jaws 24 and 22.

In contrast, the present invention is directed to a surgical apparatus that incorporates, among other elements, a prime mover that is movably positioned within a hollow manipulation shaft. The prime mover, according to the present invention, is adapted to be activated by an actuator located at a proximal end of the shaft. In contrast, the Freitas et al. device utilizes the probe sleeve as the moving element to accomplish closure of the jaws 22 and 24.

As these elements are presently found in all the independent claims (1, 10, 15, 19, 24, 29 and 36) the Freitas et al. device cannot anticipate those claims. For the Freitas et al. reference to anticipate these claims, each and every element must be recited in the reference. As pointed out above, the critical elements presently claimed are missing from the reference.

As such, the rejection of claims 1, 4, 10, 11, 15, 16, 19 – 21, 24, 25, 29, 32, 36 and 37 under 35 U.S.C. §102(b) as being anticipated by Freitas et al. should be withdrawn.

#### Claim rejection under 35 U.S.C. §103

The Examiners rejection of claims 2, 3, 12, 13, 14, 17, 18, 26, 30, 31, 38 and 39 as being unpatentable over Freitas et al. is traversed.

The Examiner takes the position that Freitas et al. fails to describe the limitations found in these claims relating to a coupler including a lateral slot or a hook shaped tine. The Applicants disagree that such features would be obvious to one of ordinary skill in the art. A coupler having a lateral slot or a hook shaped tine is not an unpatentable design choice.

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Freitas et al. fails to render obvious these claims, as it has also failed to anticipate the first group of claims, due to the fact that the Freitas et al. device does not suggest nor disclose a surgical instrument formed with a hollow manipulation shaft receiving a prime mover activated by an actuator located at a proximal end of the shaft. This is a fundamental and critical difference between the Freitas et al. device and the presently claimed invention. Further, the coupler of the present apparatus, which is formed about the distal end of the shaft, will have a generally hook shaped anchor having an engagement face and a capture ledge that defines a lateral slot in the tool, the ledge being adapted to releasably mate to the engagement face. The Examiner's attention is specifically drawn to claim 14.

For these reasons, the Examiner's rejection of claims 2, 3, 12, 13, 14, 17, 18, 26, 30, 31, 38 and 29 should be withdrawn.

The Examiner's rejection of claims 5, 6, 8, 9, 22, 23, 27, 28, 33, 34 and 40 - 42 under 35 U.S.C. §103(a) as being unpatentable over Freitas et al. in view of Chien (GB 227412A) is traversed. The Chien reference is directed to a disposable dental explorer with a frangible handle. The disposable dental explorer has a plastic handle coupled to a stainless steel needle. The handle is provided with a neck portion having a reduced cross-sectional area. Initially, the Applicants would argue that the combination of Chien and Freitas et al. is inappropriate, as Chien is totally non-analogous art. The Chien device is a dental device that is totally removed from the laproscopic surgical apparatus disclosed in the present invention and in the Freitas et al. reference. The Examiner has inappropriately combined these references and extracted from Chien the notched frangible portion. Neither Chain nor Freitas et al. suggest or disclose a laproscopic apparatus that uses a frangible portion to limit the use of the end tool to a single use. One embodiment of the present invention is directed to such a frangible portion that ensures the

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sterility of the apparatus and/or the end tool prior to use. While the Applicants would concur that frangible portions for the breaking of an object is well known, there is no suggestion nor disclosure in either of the Examiner's references that addresses this problem of non-reusability. For these reasons and the reasons discussed above, the Examiner's combination of Freitas et al. and Chien is inappropriate and the rejection of claims 5, 6, 8, 9, 22, 23, 27, 28, 33, 34 and 40 – 42 should be withdrawn.

Examiner's rejection of claims 7 and 35 under 35 U.S.C. §103(a) as being unpatentable over Freitas et al. as applied to claims 2 and 30 above, and further in view of Chien is traversed. Again, Freitas et al. fails to teach all the limitations of these claims as set forth above. Further, the combination of Chien with Freitas et al. is inappropriate, as Chien is not analogous prior art. Therefore, the Examiner's assertion that it would have been obvious to one of ordinary skill in the art at the time of invention to include a frangible portion, such as the notch portion in Chien to the device of Freitas et al. to ensure that the interchangeable tool device is not used again is inappropriate and fails to establish a *prima facie* case of obviousness. As such, the rejection of these claims should be withdrawn.

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### Conclusion

In light of the amendment to the claims and these remarks, it is believed that each and every rejection raised by the Examiner has been overcome. It is the Applicant's position that the claims are in a condition for allowance. Allowance of the claims is respectfully solicited.

Should the Examiner have any questions or concerns prior to passing this case onto allowance, he is invited to contact the Applicants' undersigned representative.

Respectfully submitted,

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